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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,044	01/28/2002	David B. Sutton	6778-000001/COB	6585

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,044

Applicant(s)

SUTTON ET AL.

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/29/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19,21-30 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 15-19,21-30 and 32-37 is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-19, 21-30 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi et al. (US Patent No. 6,473,500).

As per claim 26, Risafi et al disclose a method of distributing an electronic cash card (see the abstract) comprising the steps of:
providing an unfunded cash card to a retail outlet from a purchase intermediary;
associating the cash card with data in a data file, wherein the data file indicates that the card has not been funded;
funding the cash card at the retail outlet upon purchase of the cash card for a predetermined value by a purchaser;
updating the data file upon funding of the cash card at the retail outlet; and
remitting a fee to the retail outlet after the cash card has been funded.

As per these features, applicant is directed to column 3, line 53 to column 5, line 10 and column 7, line 47 to column 8, line 34.

Risafi et al further teach providing a logo of the card issuer on the cash card thus constituting an advertisement associated with the cash card.

Remarks:

Applicant has amended the independent claims 15 and 26 to recite "updating the data file with a value for the cash card... wherein the value for the cash card is more than the purchase price of the cash card" and argued that Risafi et al do not teach or suggest this feature.

In response, the Examiner notes that in the system of Risafi et al. a user purchases the card and provides payment in cash, check or credit. See column 10, lines 35-38 of Risafi et al. all updates are made in a data file as the card is being used. See columns 9 and 10 of Risafi et al. Risafi et al further teach that the card can be reloaded by adding additional funds to the card. Thus, by performing this function, it would have been obvious to one of ordinary skill in the art to note that the cash card is being updated with the value of the cash card being more than the purchase price of the cash card so that the card continuously holds funds to be used by a customer.

Furthermore, even assuming that such a feature was not present in Risafi et al, the Examiner notes that such a feature is not an inventive concept which merits patentable subject matter as such is only a measure left by the card issuer and/or the card user.

As per claim 16, Risafi et al disclose the step of activating the cash card by registration with the purchase intermediary (column 11, line 58 to column 12, line 52)..

As per claim 17, Risafi et al disclose the step of remitting a commission to the retail outlet upon activation of the cash card (column 11, line 58 to column 12, line 52).

As per claim 18, Risafi et al disclose comprising providing the cash card to the retail outlet via a distributor of goods to the retail outlet other than the cash card (column 3, line 52 to column 4, line 16).

As per claim 19, Risafi et al disclose the step of selling the card to the retail outlet for an amount less than the predetermined value of the card (column 11, line 58 to column 12, line 52).

As per claim 21, Risafi et al disclose the step of providing an unfunded cash card further comprises ordering the cash card from a credit card provider. See figures 4, and 5a and 5b.

As per claim 22, Risafi et al disclose the credit card provider associates the cash card with data in a data file. See figures 4 and 5a and 5b.

As per claim 23, the step of manufacturing the cash card with a cash card carrier for supporting the cash card is inherent in the system of Risafi et al.

As per claim 24, the method of claim 23 further comprises the step of providing at least one of advertisement and coupons on the cash card. See column 17, line 65 to column 18, line 3 and column 8, lines 15-21 of Risafi et al.

As per claim 25, Risafi et al disclose the steps of: activating the cash card over a network by registering the purchased cash card with the purchase intermediary; and providing at least one of advertisement and coupons over the network for presentation to the purchaser. See column 17, line 65 to column 18, line 3 and column 8, lines 15-21; and column 8, lines 53-67 of Risafi et al.

Claims 26-30 and 32-35 contain similar limitations addressed in claims 15-19 and 21-25, and therefore are rejected under a similar rationale.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-19, and 21-24 are rejected under 35 USC 101 because it is directed to non-statutory subject matter, specifically as directed to an abstract idea.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP
December 22, 2004


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628